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MICHAEL RODAK, JR., CLERK

IN THE

Supreme Court of the United States

October Term, 1976

No. 76-488

ROANWELL CORPORATION

Petitioner,

v.

PLANTRONICS, INC.

Respondent.

**PETITION FOR A WRIT OF CERTIORARI TO
THE UNITED STATES COURT OF APPEALS
FOR THE SECOND CIRCUIT**

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Petitioner prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Second Circuit entered in this case on June 15, 1976.

Citation to Opinions Below

The district court's opinions in this case are reported at 185 USPQ* 505 (SDNY 1975) and 403 F.Supp. 138 (SDNY 1975), and appear as Appendices A and B of the separate volume being submitted with this petition; the opinion of the Court of Appeals is reported at 535 F.2d 1397 (2 Cir. 1976), and appears as Appendix C; and the order by the Court of Appeals denying a rehearing has not been reported, but appears as Appendix D.

* Not otherwise reported.

Jurisdiction

The Jurisdiction of this Court is invoked under 28 U.S.C. 1245(1), as to the judgment by the Court of Appeals entered June 15, 1976, a petition for rehearing having been denied by the Court of Appeals on July 2, 1976.

Questions Presented

The questions presented by this petition are the following:

1. Whether a patent will be enforced by the courts to accord exclusivity for an invention notwithstanding the patentee's conduct in:

(a) fraudulently extending the monopoly for that invention to foreign countries, by applying for and obtaining a British patent after being advised that it was barred by law, for the purpose of setting up a European exclusive licensee; and

(b) knowingly predicating an anti-competitive exclusive license for Europe upon the fraudulently-filed British patent application—the exclusive license containing restraints against the licensee attacking the validity of any of the licensor's patents, exporting to the United States or elsewhere outside the licensed territory, or selling in any area occupied by the licensee or any of its designees for three years after the termination of the license;

2. Whether this Court's designation of commercial success and similar factors as "secondary considerations", in determinations of obviousness under Section 103 of the Patent Act, means merely that these factors should be con-

sidered second in time sequence, after a preliminary determination has been made of the subject matter in issue, or that they are indeed secondary in importance;

3. Whether the responsibility of a Court of Appeals to accord appellate review in patent cases is so reduced where the district court judge is a former patent lawyer, even where simple technology is involved, that the court may decline to review and rule on such issues as enforceability and obviousness; and

4. Whether an invention based upon a combination of old elements is patentable where it purports to rest upon the substitution of one element in a prior art combination, and where

(a) that substitution is specifically taught in the prior art; and

(b) no synergistic effect results from the claimed combination.

Statutes Involved

"§ 103. *Conditions for patentability; non-obvious subject matter*

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made." 35 U.S.C. 103.

“§ 286. *Time limitation on damages*

Except as otherwise provided by law, no recovery shall be had for any infringement committed more than six years prior to the filing of the complaint or counterclaim for infringement in the action. . . .” 35 U.S.C. 286.

Statement of the Case

Prior Proceedings.

This is a patent infringement suit based upon three patents, only one of which is involved in this petition, namely Larkin patent 3,184,556. Jurisdiction was based upon 28 U.S.C. 1338(a).

After a bench trial the district court held two of the patents in suit invalid for obviousness but the Larkin patent valid and infringed (Appendix B), and both sides appealed.

Just prior to trial the district court granted plaintiff's motion to strike from defendant's Answer the defense of unenforceability based upon plaintiff's fraudulent conduct in applying for and securing a knowingly invalid British patent, and knowingly predicating an exclusive and restrictive European license on the fraudulent British application. (Appendix A) Defendant also appealed from this ruling.

The Court of Appeals ruled that the record amply supports the district court's finding that the Larkin invention was not anticipated, and then affirmed on the opinion below, without even mentioning either the issue of obviousness as to the Larkin patent, or the question of its enforceability. Indeed, the enforceability issue was neither raised nor treated in the “opinion below” which is referred to in the Court of Appeals' opinion. (Appendix C)

Defendant petitioned for a rehearing of the issues of obviousness and enforceability as to the Larkin patent, and this petition was denied. (Appendix D)

Larkin Patent.

The Larkin patent in suit concerns a lightweight headset for use by airline pilots and others in voice communications. (Ex.App. 1) *

Rather than having the small microphone (or “mike”) of the headset in front of the user's mouth, supported by a lightweight arm or “boom”, which would render it positionally unstable, the Larkin invention involves mounting the microphone and receiver together, in a housing on an eyeglass frame or headband, and using hollow tubes to couple the sound from the mike and receiver to the mouth and ear.

Thus, the Larkin headset includes a *voice* tube which carries sound from the wearer's mouth to the microphone, and an *ear* tube which carries sound from the receiver into the wearer's ear.

Larkin initially filed a patent application claiming to have been the first to use a voice tube in a lightweight headset, but the Examiner cited references showing this to be old. Larkin then amended his claims to include an ear tube, and asserted:

“All the claims have been amended to define a headset in which the transducers [mike and re-

* The designation “Ex.App.” refers to the Exhibit Appendix filed in the Court of Appeals. The first page of the drawing of the Larkin patent, and claim 1, which is the only claim plaintiff is relying upon, also appear in the accompanying Appendix E, page 33a.

ceiver] are held adjacent to the wearer's ear, and in which *two* tubes are used, one from the microphone to the mouth and the other from the receiver to the ear. This arrangement is not shown by the . . . [references] cited by the Examiner." (Ex.App. 258)

Thereafter, without making any further search, the Examiner allowed the amended claims and the Larkin patent issued.

I. Unenforceability

As already noted, upon plaintiff's motion before trial, the district court struck from defendant's Answer the issue of plaintiff's fraud concerning the invention of the Larkin patent, and the consequent unenforceability of that patent. The Court of Appeals completely ignored this issue, notwithstanding defendant's petition for a rehearing which called attention to this omission.

The operative facts concerning this issue are not virtuous. Some three years after filing the application for the Larkin patent in suit—long after plaintiff's headsets had been on sale and illustrated in *Business Week*, the *Wall Street Journal*, and various trade publications (Ex.App. 755-760)—plaintiff's president, Mr. Larkin, desired to set up an exclusive licensee for Europe, and inquired of his patent lawyer, Mr. Jean Chognard, whether a British patent could be obtained. Mr. Chognard testified in a deposition that he found that the filing of a British application was barred by plaintiff's sales and publications, and so advised Mr. Larkin. (Ex.App. 1134, 1179-80)

Thereafter, without informing Mr. Chognard, Mr. Larkin filed a British application directly through a British patent agent, and later obtained Larkin British patent

1,009,818* (Ex.App. 1010, 1046, 1181)—thus fraudulently, and with full knowledge, extending his patent monopoly for the Larkin invention to Great Britain.

Moreover, shortly after filing the fraudulent British application, plaintiff concluded a restrictive exclusive license agreement with a British company, S.G. Brown Ltd., for all of Europe—based solely upon this knowingly fraudulent application. (Ex. App. 1017)

In this license agreement, plaintiff agreed to "seek patent coverage" in all of the licensed countries, even though Mr. Larkin had already been advised that patent coverage was barred. Also, the agreement provided that the licensee Brown would "not . . . dispute the validity of any patents" obtained by plaintiff—thus insulating from attack by Brown the fraudulent British patent and any other patents plaintiff might acquire. (Ex.App. 1017)

In a superseding license agreement three years later, the licensee agreed not to export any "Licensed Product" from the licensed territory, without the prior written approval of plaintiff—"Licensed Products" being defined not only to include "Headsets" but also assembly parts and replacement parts thereof, and "Headsets" being defined as "All models and types of headset products manufactured and marketed by [plaintiff] for general use . . .". (Ex.App. 1021-2, 1037; Appendix A, 185 USPQ at p. 507)

The superseding agreement also included a 3-year post-termination restraint against the licensee, directly or in-

* This British patent was abandoned by plaintiff shortly before the trial in this case, some nine years after its illicit grant, and more than two years after the relevant *Wall Street Journal* publication and others became known to plaintiff's present counsel—after plaintiff apparently decided, in view of defendant's motions to compel discovery, unsuccessfully opposed by plaintiff, that this matter would not be dropped.

directly, manufacturing or selling any of the "Licensed Products", or any derivations thereof, either in the licensed territory or in any area of the world in which the plaintiff or its designee is then selling such products. (Ex.App.1032)

In his ruling on plaintiff's motion to strike, Judge Conner assumed, without deciding, that "the British patent was obtained by fraud". Further, he found that the exclusive license based on this patent was "clearly anti-competitive". (Appendix A, 185 USPQ at pp. 506 & 507) However, he nevertheless held that these fraudulent and restrictive activities of plaintiff, in its dealing with the Larkin invention, cannot impede plaintiff's right to exclusivity for this invention through the enforcement of its U.S. patent.

As authority for this ruling, Judge Conner relied upon his earlier decision in *Saxton Products, Inc. v. U.S. Telephone Co.*, 182 USPQ* 608 (SDNY 1974), which incorrectly ruled that fraud perpetrated in connection with one patent cannot affect another patent, strangely enough, even where the two patents were asserted to claim the same subject matter.

While this view is apparently now the law of the Second Circuit, it has no basis in reason, since activities concerning one patent may be intimately related to another patent, and it is directly contrary to the decisions of this Court. See *Keystone Driller Co. v. General Excavator Co.*, 290 U.S. 240 (1933), where fraud in the suppression of prior art as to one of the patents in suit was held to bar relief on the five closely related patents in suit, discussed in *Chromalloy American Corp. v. Alloy Surfaces Co.*, 339 F.Supp. 859, 875-6 (DC Del. 1972); and *Precision Instruments Co. v. Automotive Co.*, 324 U.S. 806 (1945), where fraud in suppressing evidence of perjury in an interference proceeding

* Not otherwise reported.

before the Patent Office, which apparently involved only one of the three patents in suit, was held to bar relief as to all three. See, also, *East Chicago Machine Tool Corp. v. Stone Container Corp.*, 181 USPQ* 744, 748 (DC Ill. 1974).

Judge Conner also found *S.H. Kress & Company v. Aghnides*, 246 F.2d 718 (4 Cir. 1957) to support his ruling and involve a situation factually indistinguishable. However, that case did not involve a U.S. invention; or consultation with a U.S. attorney, who advised that the contemplated foreign filing was unlawful; or a fraudulent extension of the monopoly for a U.S. invention into foreign lands; or predicating a "clearly anti-competitive" European license, impeding foreign trade to the U.S., on the basis of that fraud. Nor can the possible misstatement to the Canadian Patent Office in *Aghnides*, which may or may not have been predicated on a fraudulent intent, be deemed comparable to the factual situation here.

After disposing of the question of plaintiff's fraud in securing the British Larkin patent, Judge Conner considered the S.G. Brown exclusive license and found that it was unnecessary to decide whether its "anti-competitive" nature constituted a misuse of the Larkin U.S. patent, for the reason that this license was terminated on August 30, 1972, shortly after this suit was filed, and thus "any misuse . . . which might have existed has been purged and its market effects, if any, long since fully dissipated." (Appendix A, 185 USPQ at p. 507)

This ruling ignored the 3-year carry-over prohibitions of the S.G. Brown license, and the fact that plaintiff's claim extends back six years prior to suit. 35 U.S.C. 286.

However, its most fundamental error lies in the court's separation of the anti-competitive exclusive license from

* Not otherwise reported.

the fraudulent foreign application upon which it was predicated. These activities are not separable. The foreign filing was fraudulent, and so was the exclusive license knowingly based upon this fraud. They were but successive steps in the acquisition of both an illegal monopoly in Great Britain for the Larkin invention and an anti-competitive exclusive license for all of Europe—with an illegal restraint against the shipment of any headsets competitive with plaintiff's, or parts therefor, out of the licensed territory.

This fraudulent extension of plaintiff's patent monopoly to other lands, with its other incidents, is no less relevant, and far more reprehensible in its accomplishment, than the extension of a patent monopoly beyond its prescribed time limits considered by this Court in *Brulotte v. Thys Co.*, 379 U.S. 29 (1964).

Nor is plaintiff's fraudulent conduct in effecting its aims something which can be purged, even aside from the time factors ignored by the district court. See *Kearney & Trecker Corp. v. Cincinnati Milacron, Inc.*, 184 USPQ* 134, 152 (DC Ohio 1974).

As this Court stated in *Precision Instruments*:

"A patent by its very nature is affected with a public interest . . . The far-reaching social and economic consequences of a patent, therefore, give the public a paramount interest in seeing that patent monopolies spring from backgrounds free from fraud or other inequitable conduct . . ." 324 U.S. at p. 816.

Here, the invention from which the Larkin patent sprang was enmeshed in fraud, practiced to extend the monopoly for that invention to other lands—and to provide a vehicle

* Not otherwise reported.

for controlling sales in Europe and unlawfully restricting export to this country and others. No affirmative relief should be accorded this patent.

Judge Conner, however, dismissed the fraud issue from the defendant's Answer, without trial, on the ground that it relates only to the invention for which the Larkin patent was awarded, and not to the patent itself. This case and *Saxton* thus establish a rule of law in fundamental disagreement with the strong public interest expressed in the decisions of this Court.

II. Secondary Factors

In *Graham v. John Deere Co.*, 383 U.S. 1 (1966), this Court rendered its first opinion concerning Section 103 of the Patent Act of 1952, which attempted to define the elusive concept of "invention" in statutory terms. 35 U.S.C. 103. In its opinion, the Court observed that, without changing the standard of invention previously applied, Section 103 has established "nonobviousness" as the operative test for patentability. And, further, that Section 103 calls for certain background factual inquiries as to "the scope and content of the prior art", the "differences between the prior art and the claims at issue", and "the level of ordinary skill in the pertinent art". *Graham v. John Deere Co.*, *supra*, 383 U.S. at p. 17; *Dann v. Johnston*, — U.S. —, 96 S.Ct. 1393 (1976).

The Court in *Graham* also indicated that "secondary considerations" such as commercial success "might be utilized" and "may have relevancy", stating:

"Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the cir-

cumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy." 383 U.S. at pp. 17-18.

The requirements laid down in *Graham* have been said to require strict adherence, *id.* 383 U.S. at p. 18; *Anderson's-Black Rock v. Pavement Co.*, 396 U.S. 57, 62 (1969), and *Graham* has been said to present "a demanding standard of invention". *Lear, Inc. v. Adkins*, 395 U.S. 653, 676 (1969). Also, the limited role of the "secondary considerations" as determinants of obviousness has been reaffirmed in *Anderson's-Black Rock v. Pavement Co.*, *supra*; *Dann v. Johnston*, *supra*; and *Sakraida v. Ag Pro*, — U.S. —, 96 S.Ct. 1532 (1976).

This view of the role of secondary considerations was not, however, adopted by Judge Conner in this case. In *Timely Products Corp. v. Arron*, 523 F.2d 288, 294 (2 Cir. 1975), where Judge Conner sat on the Court of Appeals in its review of a patent case, he stated that:

"In referring to such factors as 'secondary considerations' the Court surely did not intend to depreciate their importance, but only to indicate that they are to be considered *after* a preliminary determination of the precise subject matter at issue has been completed." (emphasis the court's)

This was the last pronouncement by the Court of Appeals for the Second Circuit concerning the significance to be accorded "secondary considerations" prior to Judge Conner's decision in the present case, and thus, at the time of his decision in this case an erroneous standard existed as to the "secondary" nature of these considerations.

Moreover, it is clear from Judge Conner's opinion in this case that this erroneous standard controlled his decision as to the Larkin patent. Indeed, he not only expressly relied upon his own pronouncement in *Timely Products*, but he relied upon the "secondary considerations" involved in this suit to salvage a clearly obvious Larkin invention, stating:

"Viewed retrospectively, the Larkin invention would seem an obvious combination of old elements. But so would virtually every other invention which consists of a combination of mechanical and/or electrical components."

. . .

"In most validity contests it is these 'signposts' which furnish the only objective guidance and which ultimately prove dispositive. However, we must begin with the preliminary determinations directed by *Graham*." 403 F.Supp. at p. 140.

While it is defendant's view that the secondary considerations in the present case were largely fictitious, and this could be demonstrated by a discussion of their merits, whether fictitious or real, these considerations were inappropriately relied upon by the district court to the point of being "dispositive" of the issue of obviousness, contrary to the express rulings of this Court.

III. Appellate Review

The Court of Appeals appears to have abrogated its responsibility of appellate review in this case, in deference to Judge Conner's long experience with technical matters as a former patent lawyer, and his unquestioned understanding of the simple subject matter of this case. (Appendix C)

In *General Tire & Rubber Co. v. Jefferson Chemical Co., Inc.*, 497 F.2d 1283, 1284 (2 Cir. 1974), the Court of Appeals decried the absurdity of requiring that decisions in patent appeals be made by judges whose knowledge of the relevant technology derives primarily, or even solely, from explanations by counsel, judges who do not even have access to a scientifically knowledgeable staff. In contrast, in *Capri Jewelry, Inc. v. Hattie Carnegie Jewelry Enterprises, Ltd.*, — F.2d — (2 Cir. 1976) the same court extolled the deliverance of a patent lawyer to this circuit for the resolution of patent cases.

While we recognize the desirability of having technical matters considered by jurists who comprehend them, we believe that judges experienced in patent law, as other jurists, must adhere to the law as interpreted by this Court, and their presence on the district court should not render that court, even in patent cases, a *de facto* court of last resort.

This case does not involve complex technology, but a lightweight headset that uses *two* sound tubes rather than one—an ear tube being claimed by Larkin as his addition to prior art lightweight headsets, after an ear tube had been announced by others in sales flyers as “a new way to hear in headsets” to achieve “comfort, lightness, [and] all day ease”, as will be discussed. (Ex. App. 675)

Thus, the technology in this case is so simple, and the question of obviousness so clear, that patentability should be readily determinable by the application of correct legal standards, and erroneous rulings based upon incorrect standards readily correctible. *Blonder-Tongue v. University Foundation*, 402 U.S. 313, 331-2 (1971).

The Court of Appeals in this case, however, simply ruled that “The record amply supports the finding that the

Larkin patent . . . was not anticipated”, and made no ruling either as to the obviousness or enforceability of the Larkin patent. Nor did it indicate any recognition that these issues are present in the case.

While we agree that deference should be accorded the rulings of our district courts, and perhaps more so in cases where a court, as here, manifests a particular competence, we believe that the Court of Appeals in this case abrogated its responsibility of review in view of the district court’s technical competence, and set a dangerous precedent for our jurisprudential system.

IV. Obviousness

That the invention of the Larkin patent was obvious to one of ordinary skill in the art, when even minimal standards of obviousness are applied, and a proper assessment accorded secondary considerations, is clear from the following prior art combination:

Olney patent 2,485,405 (Appendix F, p. 35a), filed in the mid-1940’s, showing a headset having a small microphone and receiver located together in a housing attached to an earcap resting on the wearer’s ear, with a single or dual *voice tube* from the microphone to the wearer’s mouth (one or two tubes being used depending upon whether noise-cancellation is desired); and a later Telex sales flyer (Appendix G, p. 37a) which announced, in 1955, six years before Larkin’s work, “an entirely new way to hear with a headset”, i.e. an *ear tube* from the ear to an adjacent receiver mounted on a headband—instead of an earcap, and proclaiming “Never before such comfort, lightness, all-day-long ease of use”.

That Olney's earcap and the Telex ear tube are alternative earpieces in lightweight headsets is not only apparent from the Telex announcement; it was specifically taught in a 1957 publication by an airlines-supported organization called ARINC (Appendix H, p. 39a)—where the two alternatives are shown, in a drawing of a lightweight headset, *at opposite ends of a double-ended arrow*.

Further, the obviousness of the Larkin invention is equally clear, or perhaps even more so, from the following prior art combination:

a 1959 Telex sales flyer (Appendix I, p. 41a) showing a lightweight "boom-mike" headset which uses *ear tubes* and a miniature mike at the end of a lightweight boom—the mike being positionally unstable with rapid head movements because of its inertia at the end of the lightweight boom (Appendix B, 403 F.Supp. at p. 142); and British patent 716,801 (Appendix J, p. 45a), which specifically explains that a miniature mike at the end of a boom, in a lightweight headset, is unstable "when the head is moved due to the inertia of the microphone", and that this can be cured by fixing the mike to the headband, adjacent the receiver, and extending a *voice tube* from the mike to the wearer's mouth—just as Larkin subsequently did.

The district court's opinion failed to mention either the ARINC publication of the first prior art combination above, or British patent 716,801 of the second.

Rather, the district court referred to a different combination of prior art, as an illustration of how readily the Larkin invention can be constructed from the prior

art, but found that that combination was not suggested by either of the references. (Appendix B, 403 F.Supp. at p. 143) In contrast, however, the above two combinations are clearly suggested.

Thus, a person who had in mind the Olney voice-tube headset when he received the 1955 Telex flyer announcing an ear tube as a new, comfortable, lightweight way to hear in headsets, would not require the exercise of invention to utilize the newly announced ear tube in place of the older Olney earcap. And this is especially true after the 1957 ARINC publication, unmentioned by the district court, contained a drawing depicting the earcap and ear tube as recommended alternatives for lightweight headsets—all of which occurred prior to the alleged Larkin invention in 1961.

Likewise, one having in mind the positionally unstable lightweight boom-mike headset of the 1959 Telex flyer would not require the exercise of invention to move the mike up next to the receiver and use a voice tube, as Larkin did, after British patent 716,801 described the problem of positional instability in such headsets and stated that this is exactly how the problem should be solved.

Thus, nothing was required but to read the solution from the references, that an ear tube could be used as an alternative to an earcap in a lightweight headset, as specifically depicted by ARINC; or that the solution to the positionally unstable boom-mike in a lightweight headset is a voice tube, with the mike on the headband adjacent the receiver, as taught in British patent 716,801—both of which went unmentioned in the district court's opinion.

Nor is it relevant that Larkin chose not to avail himself of these prior art teachings. *Graham v. John Deere, supra*, 383 U.S. at pp. 19, 36.

V. Synergistic Effect

In its past considerations of patentability and nonobviousness, this Court has deplored the granting of unwarranted patent monopolies on combinations of old elements, as withdrawing useful tools from those skilled in the art, and held that, to be patentable, such combinations must give rise to a synergistic effect, that is, an effect which is greater than the sum of the several effects of its elements taken separately. *A & P Tea Co. v. Supermarket Corp.*, 340 U.S. 147 (1950); *Anderson's-Black Rock v. Pavement Co.*, *supra*; *Sakraida v. Ag Pro*, *supra*.

Thus, in *Sakraida*, Justice Brennan recently stated that:

"We cannot agree that the combination of these old elements . . . can properly be characterized as synergistic . . . Rather, this patent simply arranges old elements with each performing the same function it had been known to perform, although perhaps producing a more striking result than in previous combinations. Such combinations are not patentable under standards appropriate for a combination patent." 96 S.Ct. at p. 1537.

Similarly, the Larkin headset simply employed two known expedients, the Olney mike and voice tube for talking* and the Telex receiver and ear tube for listening—each playing precisely the same function when combined in the Larkin headset as it did when used separately.

No synergistic effect was present or required by the district court in this case—or by the Court of Appeals, since it made no ruling as to the obviousness of the Larkin invention.

* Which is also shown in other prior art references.

CONCLUSION

For the foregoing reasons, the petition for a writ of certiorari should be granted.

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